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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/595,352 06/15/00 WHITESIDE

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001688 QM12/0214
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EXAMINER

SNOW, R

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

02/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/595,352

Applicant(s)

Examiner

Bruce Snow

Group Art Unit

3738



☒ Responsive to communication(s) filed on Jun 15, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5 and 7-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5 and 7-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Oath/Declaration

Regarding applicant's statement of inoperativeness or invalidity of the original patent, applicant claims "*I believe the original patent to be partly inoperative or invalid by reason of a defective specification..*". There are no amendments made to the specification and it is unclear as to why applicant's believe the specification is defective. See MPEP 1414.

Also, applicant indicates the use of exhibits, i.e., Exhibit 1 - Exhibit 5, however, applicant fails to provide a copy of each.

Assignee

Applicant indicates that the patent was assigned to "Surgical Technologies, Inc." (Now Whiteside Biomechanics, Inc.) which conflicts with "Surgical Accessories, Inc." recorded on Reel: 007519 Frame: 0922. Please clarify.

Prior Art

Applicant's information disclosure statement, paper No. 2, fails to include the foreign patent documents and other publications cited on the patent.

Recapture

All claims are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Regarding claims 1, applicant omits the limitations:

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(1) "*acetabular component*". This limitation was surrendered during the prosecution of the parent applicant; see Amdt B, paper No. 8 of serial No. 08/466,607 (certificate of mailing 9/26/96) page 4, lines 11 et seq.

(2) "*said liner also including a separate raised locking ridge positioned to engage said interlock groove of said acetabular shell in a snap-lock arrangement*". This limitation was surrendered during the prosecution of the parent applicant; see Amdt B, paper No. 8 of serial No. 08/466,607 (certificate of mailing 9/26/96) page 4, lines 11 et seq.

Regarding claim 12, applicant omits the limitations:

(1) "*acetabular component*". This limitation was surrendered during the prosecution of the parent applicant; see Amdt B, paper No. 8 of serial No. 08/466,607 (certificate of mailing 9/26/96) page 4, lines 11 et seq.

(2) "*said liner also including a separate raised locking ridge positioned to engage said interlock groove of said acetabular shell in a snap-lock arrangement*". This limitation was surrendered during the prosecution of the parent applicant; see Amdt B, paper No. 8 of serial No. 08/466,607 (certificate of mailing 9/26/96) page 4, lines 11 et seq.

(3) "*said shell including a smooth inner sealing surface*". This limitation was surrendered during the prosecution of the parent applicant; see Amdt B, paper No. 8 of serial No. 08/466,607 (certificate of mailing 9/26/96) page 4, lines 15 et seq.

Claim Rejections - 35 USC § 112

1. Claims 1-5, 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 6, "acetabular" lacks antecedent basis.
Claim 10, "said tabs" lacks antecedent basis.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-7, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Schryver et al (5,314,487). Schryver et al teach a prosthesis comprising a shell 14 having a smooth inner sealing surface 19; and a "liner" (see figure 9) including at least one circumferential peripheral annular seal 40, said seal engaging and said smooth sealing surface to restrict migration of debris between the interface of the shell and liner.

Regarding the circumferential groove and peripheral notches, see figure 2.

Claim 12, the liner constitutes a bearing surface for another component 72, see figure 19.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parchinski (4,650,491) in view of Mikhail (5,480,448). Parchinski teaches a prosthesis comprising a shell 12 having a smooth inner sealing surface 22 (see figure 5); and a liner 14 including at least one circumferential peripheral annular seal 40, said seal engaging and said smooth sealing surface to restrict migration of debris between the interface of the shell and liner.

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However, Parchinski fails to utilize at least one screw hole. Mikhail teaches ~~it~~ it is well known to utilize at least one screw hole 40 in a shell prosthesis. It would have been obvious to one having ordinary skill in the art to have utilized at least one screw hole to more securely affix the prosthesis to an acetabulum.

Regarding the interlocking circumferential groove, see elements 28 and 38 of Parchinski.

Claim 9, see elements 30 of Parchinski and elements 129'

Claim 10, see Mikhail, figures 13-15.

Claim 11, Parchinski teaches rounded tab 48. It would be an obvious duplication of parts to have utilized more than one tab.

Any inquiry concerning this communication should be directed to Bruce Snow at (703) 308-3255. Should the examiner not be present, Applicant may call the Examiner's Supervisor Corrine McDermott at (703) 308-2111.

B.E. Snow
February 12, 2001

A handwritten signature in black ink, appearing to be 'B.E. Snow', with a long horizontal line extending to the right.

Bruce E. Snow
Primary Examiner
Group 3700